

REMARKS

Claims 1-15 are currently pending in the application. Claim 1 has been amended in response to an interview with Examiners Jackson and Bianco on January 10, 2011, as further supplemented in connection with review of additional language submitted following the interview. The foregoing separate sheets marked as "Listing of Claims" show all the claims in the application, with an indication of the current status of each.

Interview

The Examiners' consideration in the interview of January 10, 2011, and followup thereafter is acknowledged with appreciation.

Regarding use of the Woo reference, applicant's counsel argued that one skilled in the art of prosthetic devices would not reach the Woo reference from Nijenbanning, as stated more fully in the December 27, 2010, filing (hereafter "the December 27th filing"). The Examiners said that the term "locking device" enabled use of the Woo reference, and they were not persuaded by the argument that a generic reading of "locking device" to arrive at Woo exceeded the skill in the art of prosthetic devices.

The discussion then turned to the safety aspect of the invention, and in particular to that portion of the disclosure quoted at pages 6 and 7 of the December 27, 2010, filing. Although the December 27th filing had made no amendment to the claims, the interview was interrupted briefly to send a proposed amendment to claim 1 incorporating language from the quoted passages. The Examiners agreed that the proposal was constructive, but did not see in the language a structural element corresponding to the improved safety aspect of the invention.

It was agreed to consider the issue of a structural element in the claim language that would highlight the safety aspect of the invention. Subsequently, a further modification of the proposed amendment was sent to the Examiners, who concluded that the proposal simply provided a label for existing claim elements and

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therefore was not necessary. The Examiners further suggested that an automatic unlocking feature would distinguish the prior art of record, but upon reflection the invention does not disclose an automatic unlocking, which in any event would not be the novelty provided by the invention.

Further Remarks

This amendment makes of record in the case the amendment to claim 1 discussed during the interview and expands upon the two issues addressed in the interview, namely, 1) whether the teaching of the Woo reference would make obvious to one skilled in the art to seek confirmation of the locking state, and 2) whether the safety function provided by the invention can be suitably embodied in claim language.

Upon reflection these two issues are closely related. It may be helpful to consider a case cited in PTO guidance (Docket No.: PTO-P-2010-0055) issued following the Supreme Court decision in *KSR v. Teleflex*, 550 US 398 (2007). At 1358 OG 377 the Office makes the following teaching point:

“Even where a general method that could have been applied to make the claimed product was known and within the level of skill of the ordinary artisan, the claim may nevertheless be nonobvious if the problem which had suggested use of the method had been previously unknown” (emphasis supplied).

The cited case is *In re Omeprazole Patent Litigation*, 526 F.3d 1361 (Fed. Cir. 2008). The claims in question combined known prior art elements. Two layers of coatings were applied over the active ingredients of omeprazole to ensure that the drug did not disintegrate before reaching its intended site of action. Coated omeprazole tablets were known from a prior art reference, and secondary subcoatings in pharmaceutical preparations generally were also known.

However, the claimant’s “reason for applying an intervening subcoating between the prior art coating and omeprazole had been that the prior art coating was actually interacting with omeprazole, thereby contributing to undesirable degradation

of the active ingredients. This degradation of omeprazole by interaction with the prior art coating had not been recognized in the prior art. Therefore, the district court reasoned that ... a person of ordinary skill in the art would have had no reason to include a subcoating in an omeprazole pill formulation. The Federal Circuit affirmed ... because the flaws in the prior art formulation that had prompted the modification had not been recognized" (emphasis supplied).

In the case of the safety function provided by the present invention, this same characteristic is present. There is a deficiency in the prior art that had not been recognized: namely, the very problem prompting the invention – the patient fails to notice that the locked position has not been reached – is not recognized as a problem in the prior art.

It is therefore submitted that unless the Examiner can find prior art recognition of this deficiency it is no more proper to bring the Woo teaching into this case than to bring the secondary coating teaching into the *Omeprazole* case.

It is evident from pages 1 and 2 of the specification, quoted at pages 6 and 7 of the December 27th filing, that the invention responds to the unsafe condition and risk of a fall that obtains if and when a user of the prosthetic device fails to correctly observe the state of the device. The user observes the behavior of the device, but this is not always sufficient for the user to know, for example, whether the device "is in fact really locked" (page 2, lines 4-5) or that there has been an "inadvertent unlocking of the orthopedic aid" (page 2, line 32). What is provided by the invention, to overcome this deficiency, is an automatic indication of changes in the state of the device, thereby either confirming user observations (e.g. "an acknowledgment signal for the user [that] informs him that the intended locking has actually taken place," at page 3, lines 4-6) or alerting the user (e.g. by a "warning signal in the event of inadvertent unlocking of the locking device," at page 3, lines 10-12).

The amended claim language makes these features explicit, thereby articulating a safety function the need for which prompted the invention.

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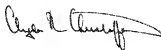
It is therefore submitted that the §103 ground of rejection as to claim 1 is overcome, and should be withdrawn. It is further submitted that claim 1 is in allowable form over the prior art, and therefore that all the remaining claims 3-15 are also allowable because they depend from allowable claim 1.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1 and 3-15 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: clyde@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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